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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,753	06/11/2001	Jose-Luis Abad-Peiro	CH919980004U	6136

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04/19/2007

EXAMINER

TINKLER, MURIEL S

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/787,753		ABAD-PEIRO ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Muriel Tinkler		3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/2007, 1/30/2004</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This application has been reviewed. Claims 1-20 are pending. The objection(s) and rejection(s) are as stated below.

#### ***Response to Amendment***

1. Claims 1-17 have been listed as amended:
  - a. Claim 5 incorrectly states the 'Currently Amended' status. There have been no changes to claim 5. Therefore an additional search for new prior art is not required.
  - b. The Amendments to Claims 1-4 and 6-17 have not added new matter to these claims, therefore an additional search for new prior art is not required.

#### ***Response to Arguments***

2. Applicant's arguments, see pages 11 and 12, filed February 6, 2007, with respect to 35 U.S.C. 112 rejection(s) of claims 1-17, as stated in the Office Action mailed on October 2, 2006 have been fully considered and are persuasive. The 35 U.S.C. 112 rejection(s) of claims 1-17, as stated in the Office Action mailed on October 2, 2006 has been withdrawn.
3. Re Applicant's arguments, filed February 6, 2007 regarding U.S.C. 103 rejection(s) have been fully considered but they are not persuasive.

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4. The Applicant states that Bardwell does not appear to be concerned with the processing power of the components of the network. Nowhere in claims 1 or 16 discusses the use or requirement of processing power. The rejection(s) of these claims are maintained.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the processing power of components) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. The Applicant states that there is no obvious motivation for combining Bardwell and Hiroya. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hiroya discusses secure mechanisms for purchase transactions as discloses in the Office Action mailed on October 2, 2006.

***Claim Objections***

7. Claim 5 is objected to because of the following informalities: Claim 5 incorrectly states the 'Currently Amended' status. Claim 5 has not been changed. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The Applicant has amended claims 2 and 17 in response to the 35 U.S.C. 112 rejections. The rejection(s) of claims 2 and 17 are withdrawn.

9. Upon further consideration of the Applicant's response, the Office has decided to withdraw the 35 U.S.C. 112 rejection(s) regarding the use of the word "may", for claims 4, 7, and 13.

10. Upon further consideration of the Applicant's response, the Office has decided to withdraw the 35 U.S.C. 112 rejection(s) regarding the use of the terms "highly secure payment protocol and "low resource intensive secure communication protocol", for claims 1-17.

11. Claims 1-6 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a *specific and substantial* asserted utility or a well established utility.

12. The amendment(s) to claims 1 and 16 now include the term, 'an improved computerized method'. While the specification does disclose that the method described is attributed to improving security, there is nowhere in the specification that suggests or describes improving a computerized method.

13. Claims 1-6 and 16-20 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a *specific and substantial* asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 18 recites the limitation "the remote site" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is no mention of a 'remote site' in claim 1. Claim 18 has been withdrawn from consideration and will not be further treated on its merits.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

19. Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardwell et al. (US 5,592,375). See the rejection(s) of these claims in the Office Action mailed on October 2, 2006.

20. Claims 2-5, 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardwell as applied to claim 1 above, in view of Hiroya et al. (EP A 0 854 462). See the rejection(s) of these claims in the Office Action mailed on October 2, 2006.

21. Claims 6, 8, 9, 11, 12, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardwell and Hiroya as applied to claims 1, 7, 10, 13 and 16 above in further view of O'Mahony (EP 0 822 535). See the rejection(s) of these claims in the Office Action mailed on October 2, 2006.

22. Claims 19 and 20 discuss the method of claim 17, wherein the communication protocol is an SSL protocol and the payment protocol is an SET protocol. O'Mahoney discloses the use of SSL and SET protocols, as discussed in the Office Action mailed on October 2, 2006. See the rejection(s) of these claims in the Office Action mailed on October 2, 2006.

### ***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-



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7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT  
April 11, 2007



HANI M. KAZIMI  
PRIMARY EXAMINER